

## **REMARKS**

Claims 1-26, 28-33, and 35-37 are pending in this application.

In the Office Action,<sup>1</sup> the Examiner rejected claims 22, 23, 25, 26, 28-30, 32, 33, and 35 under 35 U.S.C. § 103(a) as obvious over Chern et al. (U.S. Patent No. 6,381,465) in view of Angles et al. (U.S. Patent No. 5,933,811); rejected claims 1, 2, 5, 8-11, 13, 14, 16, 17, 21, 36, and 37 under 35 U.S.C. § 103(a) as obvious over Chern in view of Lee et al. (U.S. Patent No. 6,829,475) and in further view of Angles; rejected claim 3 under 35 U.S.C. § 103(a) as obvious over Chern in view of Lee, Angles, and Atsmon et al. (U.S. Patent No. 6,607,136); rejected claims 4 and 19 under 35 U.S.C. § 103(a) as obvious over Chern in view of Lee, Angles, and Maxwell (U.S. Patent No. 6,470,181); rejected claims 6, 15, and 20 under 35 U.S.C. § 103(a) as obvious over Chern in view of Lee, Angles, and Bezos et al. (U.S. Patent No. 6,029,141); rejected claims 7, 12, and 18 under 35 U.S.C. § 103(a) as obvious over Chern in view of Lee, Angles and Matsumoto et al. (U.S. Patent No. 6,484,946); and rejected claims 24 and 31 under 35 U.S.C. § 103(a) as obvious over Chern in view of Angles and in further view of Maxwell.

### **I. REJECTION OF CLAIMS 22, 23, 25, 26, 28-30, 32, 33, AND 35**

Applicant respectfully traverses the rejection of claims 22, 23, 25, 26, 28-30, 32, 33, and 35 under 35 U.S.C. § 103(a) as obvious over Chern in view of Angles. To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8<sup>th</sup> ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8<sup>th</sup> ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8<sup>th</sup> ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8<sup>th</sup> ed. 2001).

Claim 22 recites a "method for wireless device advertising" including, among other steps, "re-formatting the advertising messages at the wireless advertising service into an appropriate format corresponding to the wireless device." Chern and Angles, whether taken alone or in combination, do not disclose or suggest at least this step of claim 22.

Chern discloses appending advertising or promotional messages to alert messages that are generated when a user selects a notification or alert service. See col. 13, lines 24-26. The Chern system sends these advertising or promotional messages in SMS (Short Message Service) format as text characters and appends the messages to the alert message. See col. 13, line 67 to col. 14, line 26. While Chern teaches appending SMS messages, Chern does not teach re-formatting advertising messages into a format corresponding to a wireless device. Instead, advertising messages are sent by the Chern system in SMS format. Accordingly, Chern does not disclose or suggest at least "re-formatting the advertising messages at the wireless

advertising service into an appropriate format corresponding to the wireless device,” as recited in claim 22.

In the rejection, with respect to the above step, the Examiner cites column 8, lines 37-43 and column 7, lines 27-33 of Chern. See Office Action, page 2. Applicant respectfully disagrees that the cited portion discloses or suggests “re-formatting the advertising messages at the wireless advertising service into an appropriate format corresponding to the wireless device,” as recited in claim 22, for at least the following reasons.

Instead, in the cited portion, Chern teaches a method whereby a “user initiates a request for information.” See col. 6, line 66 to col. 7, line 1. Once a user has made the request, “handset 130 sends the request to server 136 via wireless network 140” and “server 136 retrieves the data or information requested from database 138.” See col. 7, lines 23-31. The retrieved data “may be ... usable in raw form, or it may need to be processed.” See col. 7, lines 27-28. This retrieved data, however, is the result of a user-initiated request for information and provides a result of the user’s search request (see, for example, col. 6, lines 35-37). Specifically, as disclosed by Chern, as a result of a user-initiated request or search for information, “server 136 may retrieve locations of restaurants, gas stations, hotels, or other facilities or services near the user.” See col. 7, lines 52-54. Chern also discloses that “user information ... is useful to server 136 in formatting a response to information requests based on the user’s past preferences” (emphasis added). See col. 8, lines 40-43. Retrieving information requested by a user and processing such information or formatting retrieved information requested by a user does not disclose or suggest “re-formatting the advertising messages at the wireless

advertising service into an appropriate format corresponding to the wireless device,” as recited in claim 22 (emphasis added). Chern therefore does not teach all of the steps recited in claim 22.

Angles also does not make for up the above deficiencies of Chern. In the Office Action, the Examiner alleges Angles “teaches a method and system for delivering customized advertisements within [an] interactive communication environment, including paying registered users for accepting advertisement messages transmitted to registered user terminals ... wherein said transmitted advertisement messages are based upon user profiles and ... wherein a portion of advertising revenue goes to the user as reduced access fee” (emphasis omitted). See Office Action, page 3. Even assuming the Examiner’s allegations were correct, which Applicant does not concede, Angles does not disclose or suggest at least “re-formatting the advertising messages at the wireless advertising service into an appropriate format corresponding to the wireless device,” as recited in claim 22. For at least the above reasons, Chern and Angles, alone or in combination, do not disclose or suggest claim 22. The Examiner should therefore withdraw the rejection of claim 22 under 35 U.S.C. § 103(a).

Independent claim 29, while of a different scope from claim 22, includes recitations similar to those discussed above with regard to claim 22. Accordingly, Chern and Angles, alone or in combination, also do not disclose or suggest all elements of claim 29. Therefore, the Examiner should also withdraw the rejection of claim 29 and the rejection of dependent claims 23, 25, 26, 28, 30, 32, 33, and 35, which depend from one of allowable independent claims 22 and 29.

**II. REJECTION OF CLAIMS 1, 2, 5, 8-11, 13, 14, 16, 17, 21, 26, AND 27**

Applicant respectfully traverses the rejection of claims 1, 2, 5, 8-11, 13, 14, 16, 17, 21, 36, and 37 under 35 U.S.C. § 103(a) as obvious over Chern in view of Lee and in further view of Angles.

Claim 1 recites a “method of wireless device advertising” including, among other steps, “re-formatting the advertising messages into an appropriate format corresponding to the wireless device.” As discussed above, Chern and Angles, whether taken alone or in combination, do not disclose or suggest at least this step. Furthermore, Lee does not compensate for the above-described deficiency of Chern and Angles. In the Office Action, the Examiner alleges Lee “teaches a method and system for transmitting advertising messages to wireless devices wherein prior to receiving said advertising messages, a user has to register his/her wireless device.” See Office Action, page 4. Even assuming the Examiner’s allegations were correct, which Applicant does not concede, Lee does not disclose or suggest at least “re-formatting the advertising messages into an appropriate format corresponding to the wireless device,” as recited in claim 1. For at least the above reasons, Chern, Lee, and Angles, whether taken alone or in combination, do not disclose or suggest claim 1. The Examiner should therefore withdraw the rejection of claim 1 under 35 U.S.C. § 103(a).

Independent claims 11 and 17, while of a different scope from claim 1 and each other, include recitations similar to those discussed above with regard to claim 1. Accordingly, Chern, Lee, and Angles, alone or in combination, also do not disclose or suggest claims 11 and 17. Accordingly, the Examiner should also withdraw the rejection of claims 11 and 17 under 35 U.S.C. § 103(a) and the rejection of dependent

claims 2, 5, 8-10, 13, 14, 16, 21, 36, and 37, which depend from one of allowable independent claims 11 and 17.

### **III. REJECTION OF CLAIM 3**

Applicant respectfully traverses the rejection of claim 3 under 35 U.S.C. § 103(a) as obvious over Chern in view of Lee, Angles, and Atsmon. Claim 3 depends from allowable claim 1, which includes a step of “re-formatting the advertising messages into an appropriate format corresponding to the wireless device.” As discussed above, Chern, Lee, and Angles, whether taken alone or in combination, do not disclose or suggest at least this step. Furthermore, Atsmon does not compensate for the above-described deficiency of Chern, Lee, and Angles. In the Office Action, the Examiner alleges Atsmon “teaches a method for interacting with a broadcast media (TV or PC) to receiver coupons and sales special offers, wherein users receive incentive points as a reward for watching [the] advertisement.” See Office Action, page 9. Even assuming the Examiner’s allegations were correct, which Applicant does not concede, Atsmon does not disclose or suggest at least “re-formatting the advertising messages into an appropriate format corresponding to the wireless device,” as recited in claim 1. For at least the above reasons, Chern, Lee, Angles, and Atsmon, whether taken alone or in combination, do not disclose or suggest claim 3. The Examiner should therefore withdraw the rejection of claim 3 under 35 U.S.C. § 103(a).

#### **IV. REJECTION OF CLAIMS 4 AND 19**

Applicant respectfully traverses the rejection of claims 4 and 19 under 35 U.S.C. § 103(a) as obvious over Chern in view of Lee, Angles, and Maxwell. Claims 4 and 19 respectively depend from allowable claims 1 and 17. As discussed above, Chern, Lee, and Angles do not disclose or suggest all of the elements of claims 1 and 17. Furthermore, Maxwell does not compensate for the above-described deficiency of Chern, Lee, and Angles. In the Office Action, the Examiner alleges Maxwell “teaches a method and system for delivery of advertising messages to cell phones, wherein an advertiser pays a portion of the airtime cost of a call originated by a mobile subscriber after that subscriber has listened to a recorded advertisement.” See Office Action, page 10. Even assuming the Examiner’s allegations were correct, which Applicant does not concede, Maxwell does not disclose or suggest at least “re-formatting the advertising messages into an appropriate format corresponding to the wireless device” as recited in claim 1 or “re-formatting the advertising message into an appropriate format corresponding to the wireless device” as recited in claim 17. Accordingly, Chern, Lee, Angles, and Maxwell, whether taken alone or in combination, do not disclose or suggest claims all elements required by claims 4 and 19. The Examiner should therefore withdraw the rejection of claims 4 and 19 under 35 U.S.C. § 103(a).

#### **V. REJECTION OF CLAIMS 6, 15, AND 20**

Applicant respectfully traverses the rejection of claims 6, 15, and 20 under 35 U.S.C. § 103(a) as obvious over Chern in view of Lee, Angles, and Bezos. Claims 6 and 15, and claim 20 respectively depend from allowable claims 1 and 17. As

discussed above, Chern, Lee, and Angles do not disclose or suggest all of the elements of claims 1 and 17. Furthermore, Bezos does not compensate for the above-described deficiency of Chern, Lee, and Angles. In the Office Action, the Examiner alleges Bezos “teaches a method and system for an internet-based customer referral system, wherein registered users receive commissions for referring other users to [a] merchant’s site.” See Office Action, page 10. Even assuming the Examiner’s allegations were correct, which Applicant does not concede, Bezos does not disclose or suggest at least “re-formatting the advertising messages into an appropriate format corresponding to the wireless device” as recited in claim 1 or “re-formatting the advertising message into an appropriate format corresponding to the wireless device” as recited in claim 17. Accordingly, Chern, Lee, Angles, and Bezos, whether taken alone or in combination, do not disclose or suggest all elements required by claims 6 and 15, and claim 20. The Examiner should therefore withdraw the rejection of claims 6, 15, and 20 under 35 U.S.C. § 103(a).

#### **VI. REJECTION OF CLAIMS 7, 12, AND 18**

Applicant respectfully traverses the rejection of claims 7, 12, and 18 under 35 U.S.C. § 103(a) as obvious over Chern in view of Lee, Angles and Matsumoto. Claims 7 and 12, and claim 18 respectively depend from allowable claims 1 and 17. As discussed above, Chern, Lee, and Angles do not disclose or suggest all of the elements of claims 1 and 17. Furthermore, Matsumoto does not compensate for the above-described deficiency of Chern, Lee, and Angles. In the Office Action, the Examiner alleges Matsumoto “teaches a method for accessing and displaying information related



to [an] electronic money transaction, wherein a user is able to ... [access] his account to review confidential information, including points accumulated and redeemed at participating merchants.” See Office Action, page 11. Even assuming the Examiner’s allegations were correct, which Applicant does not concede, Matsumoto does not disclose or suggest at least “re-formatting the advertising messages into an appropriate format corresponding to the wireless device” as recited in claim 1 or “re-formatting the advertising message into an appropriate format corresponding to the wireless device” as recited in claim 17. Accordingly, Chern, Lee, Angles, and Matsumoto, whether taken alone or in combination, do not disclose or suggest all elements required by claims 7 and 12, and claim 18. The Examiner should therefore withdraw the rejection of claims 7, 12, and 18 under 35 U.S.C. § 103(a).

#### **VII. REJECTION OF CLAIMS 24 AND 31**

Applicant respectfully traverses the rejection of claims 24 and 31 under 35 U.S.C. § 103(a) as obvious over Chern in view of Angles and in further view of Maxwell. Claims 24 and 31 respectively depend from allowable claims 22 and 29, the elements of which are neither disclosed nor suggested by Chern and Angles. Further, as noted above in the discussion of claims 4 and 19, Maxwell also does not make up for the deficiencies of Chern and Angles. Accordingly, Chern, Angles, and Maxwell, whether taken alone or in combination, do not disclose or suggest all of the elements required by claims 24 and 31. The Examiner should therefore withdraw the rejection of claims 24 and 31 under 35 U.S.C. § 103(a).

**CONCLUSION**

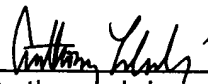
In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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